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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,458	10/29/2001	Josephine Telesca	J6701(C)	1622

201 7590 10/25/2004

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EXAMINER

GHALL, ISIS A D

ART UNIT PAPER NUMBER

1615

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/022,458

Applicant(s)

TELESCA ET AL.

Examiner

Isis Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The receipt is acknowledged applicants' amendment and terminal disclaimer, both filed 08/13/2004.

Claims 8-10 have been added. Claims 1-10 are included in the prosecution.

#### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 08/13/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any of the copending Application No. 10/022,457, and the copending Application No. 10/370,855 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: between step (B) after applying the cosmetic product and step (C) placing the adhesive

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surface of the strip against the skin treated with the cosmetic product. It is not defined in the claims or in the specification when the adhesive strip is placed? Is it right after the application of the cosmetic product and on top of it, or after elapsing of time of action of the cosmetic product to evaluate its effect? Clarification is requested.

### ***Response to Arguments***

3. Applicants' arguments filed 08/13/2004 have been fully considered but they are not persuasive. Applicants argue that the exact timing in placement of the strip against the skin is not crucial because the anti-aging cosmetic treatments require time to operate on the skin, weeks not hours or days. Measurement with the strip can occur directly after rub-in of the cosmetic product, hours later or even days later. After a treatment period of time, such as four weeks, another imprint is taken and can then be repeated at any time interval.

In response to the above argument, the examiner position is that if the adhesive strip is placed on the skin immediately after applying the cosmetic product, then the imprints on the adhesive may not be accurate because the skin pores and fine lines will be masked or covered by the cosmetic product. Furthermore, the claims are broad regarding the cosmetic product, and the term encompasses all products including skin patches and masks, and if the adhesive strip is applied directly after applying the cosmetic product in the form of patch or mask it will provide misleading results from the patch or the mask and not the actual skin configuration. In addition, as applicants state in their response, the anti-aging treatments requires some time to operate and taking an immediate skin imprint after applying the cosmetic product will not be helpful in the

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method for evaluating the efficacy of anti-aging cosmetic product. Thus, the examiner maintains the position that essential step is omitted and that is giving time for the cosmetic product to act on the skin and then remove the product before evaluating the efficacy of the product.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,088,502 ('502).

US '502 disclosed a device for sampling the surface of the skin including a substrate layer and an optically clear adhesive layer disposed on the substrate. The adhesive follows and conforms to the configuration of the surface of the skin under pressure, i.e. pressure sensitive adhesive that has sufficient tack to maintain an imprint of the skin (abstract; col.1, lines 41-48; col.2, lines 6-10). The nature of the skin surface is visualized by contrast against dark colored substrate (col.2, lines 3-34). The claims are anticipated by the reference since it has been held by the court that when the only difference between the prior art product and the claim is the "written instruction to the consumer", the claim is anticipated by the art. See *In re Ngai* 03-1524.

### ***Response to Arguments***

5. Applicants' arguments filed 08/13/2004 have been fully considered but they are not persuasive. Applicants traverse the above rejection by arguing that nowhere in the reference is there a mention of visualizing fine lines and wrinkles or any actual imprint of fine lines and wrinkles remain after removal of the strip from the skin. Indeed, US '502

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discloses that when the adhesive substrate is pressed against the skin surface, skin cells adhere to the adhesive layer. It is the transferred dry skin flakes that become imaged on a darkened area.

In response to the above argument, the examiner position is that the rejected claims are directed to product comprising adhesive transparent strip and imaging substrate. The prior art disclosed both elements of the product: transparent adhesive and substrate. The future intended use of the product does not impart patentability to the product claims, absent evidence to the contrary. Therefore, the reference anticipates the claims.

### ***Claim Rejections - 35 USC § 103***

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '502 in view of US 6,270,783 ('783).

The teachings of US '502 are discussed above, however, the reference does not teach the adhesive as acrylic adhesive.

US '783 teaches a skin adhesive strip comprising a substrate and an adhesive layer with the most preferred adhesive is the acrylic polymer as it provides the required tackiness to the skin (abstract; col.4, lines 38-43, 38-39, 57).

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the adhesive strip disclosed by US '502 and select the acrylic adhesive polymer motivated by the teaching of US '783 that the acrylic adhesive is the most preferred as it provides the required tackiness to the skin, with reasonable

expectation of having strip comprising an acrylic adhesive and substrate that provides the required tackiness to the skin of the user.

### ***Response to Arguments***

7. Applicant's arguments filed 08/13/2004 have been fully considered but they are not persuasive. Applicants argue that both references are deficient in not disclosing a transparent strip having sufficient tack to maintain an imprint of fine lines and wrinkles after removal of the strip from the skin. US '502 disclosed sampling device intended to image dry skin flakes. Still further, applicants view the claim preamble for visualizing fine lines and wrinkles as being an element of the claims. This preamble is intended to give life and meaning to the claims. Neither of the references mentions anything with respect to visualizing fine lines and wrinkles. Based on all the foregoing reasons, a combination of US '502 in view of US '783 would not render the instant invention obvious.

In response to the above argument, the examiner position is that it is that the rejected claims recite a product comprising transparent adhesive strip and substrate, and the US '502 disclosed both elements. The recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The recitation of the such intended use in the claim permeable does not limit the scope of the claim since such statement merely define the context in which the invention operates, and the body of the claim defined the subject matter of the claimed invention. The claims are directed to a product, and all the elements of the product are recited in

the body of the claim, and the permeable is not essential to understand limitations or terms in the claim body and does not provide antecedent basis for terms in the body of the claim. It is well established that the claims are given the broadest interpretation during examination. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Regarding US '783, the reference is relied upon for the sole teaching of the acrylic adhesive suitable for cosmetic products.

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103 (a).

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 564,573 (573) in view of US '502.

US '573 discloses a device used to three-dimensionally map the skin structure as exactly, a very high resolution of the measured values being essential for the purpose of proving the effect of skin treatment preparation in order to be able to detect changes in skin structure at interval time by analyzing the map on an adhesive sheet (col.1, lines 9-15; col.3, lines 50-60). The device comprises transparent sheet with adhesive side and a support sheet (abstract; col.3, lines 15-20).



The reference does not teach placing the sheet on dark imaging substrate. However, the reference recognized three-dimensional mapping the skin surface to evaluate the effect of the skin treatment.

US '502 teaches a device for sampling the surface of the skin including a substrate layer and an optically clear adhesive layer disposed on the substrate. The adhesive follows and conforms to the configuration of the surface of the skin under pressure, i.e. pressure sensitive adhesive that has sufficient tack to maintain an imprint of the skin (abstract; col.1, lines 41-48; col.2, lines 6-10). The nature of the skin surface is visualized by contrast against dark colored substrate (col.2, lines 3-34). The device provides easy application with repeatable results for uniform testing of skin surface (col.2, lines 34-35).

Thus, it would have been obvious to one having ordinary skill in the art the time the invention was made to provide a method for evaluating efficacy of cosmetic treatment on the skin surface by mapping the texture of the surface of the skin as disclosed by US '573, and use the device comprising dark imaging substrate to visualize the obtained texture as disclosed by US '502, motivated by the teaching of US '502 that the device provides easy application with repeatable results for uniform testing of skin surface, with reasonable expectation of having a method for testing the efficacy of a cosmetic product that affects the texture of the skin, i.e. wrinkles, wherein said method is easy and repeatable.

***Response to Arguments***

9. Applicant's arguments filed 08/13/2004 have been fully considered but they are not persuasive. Applicants traverse the above rejection by arguing that without a mechanism for storing the imprint in an undisturbed state and US '573 does not teach how to maintain that image for any prolonged period of time. The Examiner has admitted that US '573 does not disclose placing the imprinted sheet on a dark imaging substrate. US '502 utilizes a transparent adhesive tape to which a black background is affixed and the patterned adhesive is open to the air and subject to attracting dust or other image destroying factors. By contrast, applicants have an adhesive printed side is placed face-to-face to the darkened area of the imaging substrate. Now the imprint is sandwiched between the transparent strip and the dark area of the substrate. Dust, debris or other factors cannot disturb the image. Accordingly, both of the references are deficient by not disclosing or suggesting that after an imprint is achieved, fixation is needed of the imprint to review at a future time.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., storing of the imprint under undisturbed state, protected from dust or stored for future use) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest

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to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103 (a).

10. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2284145 ('154) in view of US '502.

GB '154 teaches an anti-aging composition and method for testing its effect on the skin by measuring the depth of the wrinkles and skin firmness by applying adhesive impression mixture uniformly on the test area, then removing it and read it by binocular magnifier (abstract; page 3, lines 22-25; page 4, lines 26-34; page 5, lines 1-2). The test

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evaluates the structural components of the micro-contour of the skin to evaluate the effect of the cosmetics (page 3, lines 26-30). The impressions are taken on treated skin before applying the cosmetic, and frequently after to test the efficacy of the cosmetic (page 4, lines 14-18, 35-38; page 5, lines 8-14).

The reference does not teach placing the sheet on dark imaging substrate. However, the reference teaches taking impression from the skin surface to evaluate the effect of the skin anti-aging treatment.

US '502 teaches a device for sampling the surface of the skin including a substrate layer and an optically clear adhesive layer disposed on the substrate. The adhesive follows and conforms to the configuration of the surface of the skin under pressure, i.e. pressure sensitive adhesive that has sufficient tack to maintain an imprint of the skin (abstract; col.1, lines 41-48; col.2, lines 6-10). The nature of the skin surface is visualized by contrast against dark colored substrate (col.2, lines 3-34). The device provides easy application with repeatable results for uniform testing of skin surface (col.2, lines 34-35).

Thus, it would have been obvious to one having ordinary skill in the art the time the invention was made to provide a method for evaluating efficacy of anti-aging treatment on the skin surface by taking impressions on the treated skin before and repeatedly after treatment as disclosed by GB '154, and use adhesive device comprising strip and the dark imaging substrate to visualize the obtained texture as disclosed by US '502, motivated by the teaching of US '502 that the device provides easy application with repeatable results for uniform testing of skin surface, with

reasonable expectation of having a method for testing the efficacy of anti-aging agent on the skin, wherein said method is easy and repeatable.

***Response to Arguments***

11. Applicant's arguments filed 08/13/2004 have been fully considered but they are not persuasive. Applicants traverse the above rejection by arguing that GB '154 does not teach placing an imprinted adhesive sheet onto a dark imaging substrate. In the present invention the imprinted adhesive surface is applied face-to-face against the darkened area of an imaging substrate. By this technique, the image is fixed without fear of dust, debris or other factors altering the image. US '502 employs a method where protective film 18 is removed (no adhesive attached) and thrown away. There remains only a single substrate 12 having an adhesive layer and a darkened area. This is a single item. By contrast, applicants do not discard their protective film but instead utilize two materials, one being a strip with adhesive and the other being an imaging substrate with a darkened area. The solution to the permanence problem is solved through the transparent strip and substrate. The combination sandwiches the imprinted adhesive layer between strip and substrate. This is not taught by either of the references and in combination they would not render the instant invention obvious.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., storing the imprint sandwiched between the substrate and the adhesive layer for protection from dust and future use) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103 (a).

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. FR 2,063,743 discloses a process of diagnosis of skin types by

applying an adhesive strip to provide accurate impression of the skin surface and getting imprints of wrinkles that are easy to see.

***Allowable Subject Matter***

13. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art does not teach or suggest applying dusting powder against the skin prior to placement of the adhesive surface of the strip.

14. Claims 5-10 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali  
Examiner  
Art Unit 1615

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